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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,830	04/02/2004	Donald R. Huene	6200.250DIV	8861

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Joseph W. Berenato, III
Liniak, Berenato & White, LLC
Suite 240
6550 Rock Spring Drive
Bethesda, MD 20817

EXAMINER

MILLER, CHERYL L

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,830

Applicant(s)

HUENE, DONALD R.

Examiner

Cheryl Miller

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 17 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 10 and 20. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Bosses 123, 125, have been mistakenly labeled 121 and 123 in figures 1 and 2, and on page 13, line 14. Also in figures 1 and 2, bore 130 has been mistakenly labeled 128. In figure 1, bore 132 has been mistakenly labeled 130. Pin 134 has been mistakenly labeled 136 in figure 4 and on page 13, line 13.

Claim Objections

Claim 16 is objected to because of the following informalities: Line 9 recites, "second component **distal end** being pivotably mounted between said connector second end spaced apart arms". According to the drawings, it would seem that the proximal end of the second component would be mounted with the connector. It is suggested to change "distal end" to --proximal end--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al. (US 3,765,033). See figures 9-22. Referring to claim 1, Goldberg discloses a prosthesis (fig. 19) adapted for placement in the elbow comprising a component (32a) capable of being placed in the humerus, a component (65a) capable of being placed in the ulna and adapted to pivotably engage the humeral component (32a), and an adaptor (82) having a first end (bottom end near 84) pivotably connected to the ulnar component (65a) and a second end (top end near 99) pivotably connected to the humeral component (32a).

Referring to claim 2, Goldberg discloses the humeral component (32a) to comprise a pair of arms (34a, 36a) spaced apart by a first distance and having axially aligned bores (50, 52) and the ulnar component (65a) comprising an end having a bore (88 or 86).

Referring to claim 3, Goldberg discloses the adaptor (82) first end to have a width less than the first distance (fig. 19) and a bore (84 or 99).

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Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Huene et al. (US 5,376,121). Referring to claim 1, Huene discloses a prosthetic elbow comprising a humeral component (14), an ulnar component (10) adapted to pivotably engage the humeral component (fig.1-3), and an adaptor (138+12) having a first end (74) pivotably connected to the ulnar component (10) and a second end (70+138) pivotably connected to the humeral component (14).

Referring to claim 2, Huene discloses the humeral component (14) to comprise a pair of arms (134, 126) spaced apart by a first distance (fig.3) and having axially aligned bores (128, 130) and the ulnar component (10) comprising an end having a bore (36).

Referring to claim 3, Huene discloses the adaptor first end (74) to have a width less than the first distance and a bore (78).

Referring to claim 4, Huene discloses the adaptor second end (70+138) comprising a pair of arms (144, 146) spaced apart by a second distance.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Scales et al. (US 3,708,805). Scales discloses a prosthetic joint kit comprising a first component (1) having a first end (top end in fig.1) and a second end (bottom end in fig.1) comprising a pair of spaced apart arms (8), a second component (2) having a first end (bottom end in fig.1) and a second end (top end in fig.1) comprising a bore (12), a first connector (pin 21) for pivotably connecting the first component (1) directly to the second component (2, pin 21 going through bores 9 and 12) and a second connector (14) for pivotably connecting the first component (1) indirectly to the second component (2).

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Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Wack et al. (US 6,699,290 B1). See figure 20. Wack discloses a prosthetic joint kit comprising a first component (430) having a first end (433) and a second end comprising a pair of spaced apart arms (436), a second component (410 +500) having a first end (412) and a second end comprising a bore (502), a first connector (460) for pivotably connecting the first component (430) directly to the second component (410+500) and a second connector (600) for pivotably connecting the first component (430) indirectly to the second component (410+500).

Allowable Subject Matter

Claim 16 would be allowable if rewritten to overcome the above claim objection.

Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

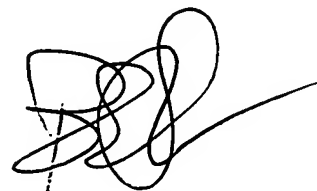
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



BRUCE SNOW
PRIMARY EXAMINER